

Examiner Zimmer has assumed this case from Examiner Nelson.

Claim Analysis

Applicant is advised that the subject matter, "said water-soluble polymer being present in said component (B¹) in an amount of from 0.01 to 5 % by weight" does, in the Examiner's estimation, merely connote product-by-process. That is to say, the invention is not an emulsion composition until such time that all of components (A), (B), and (C), have been combined and the aforementioned concentration limitation, which simply expresses a preferred mode of introduction of the water-soluble polymer, is not nearly so meaningful once all of the ingredients have been combined. In the context of a mixture of (A), (B), and (C), this phrase and the phrase "component (B¹) is contained in a proportion ranging from 50 to 250 parts by weight per 100 parts by weight of the total of (a-1) to (a-4) in component (A)" together serve to define the amount of water-soluble polymer incorporated relative the sum of the combined weight of (a-1) to (a-4). By the Examiner's calculation, using .01% of 50 parts (.0001 x 50) and 5% of 250 parts (.05 x 250), there would be between 0.005 and 12.5 parts relative to 100 parts of (a-1) to (a-4) in the final mixture.

The Examiner was unable to ascertain any patentable distinctions between the invention expressed in claims 1 and 4.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4 and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Benayoun et al., U.S. Patent Application Publication No. 2007/0099007.

At the outset, it should be noted that the lineage of this disclosure is such that it is a continuation application of an application with an effective filing date of February 14, 2001. The Examiner had attempted to find the corresponding WIPO document but, curiously, unable to locate any evidence that one was ever actually published. If one were available, it would ostensibly qualify as prior art under 35 U.S.C. 102(b).

Benayoun discloses the makeup of release coatings that are intended for application to paper substrates. A broad description of the materials from which the release coating compositions are formulated is provided in [0103-0113]. Relevant to the patentability of the instant invention, there is disclosed in Example 1 the preparation of an emulsion that contains all of the materials required by the claims with the notable exception of reinforcing filler. On the other hand the broader description [0181-0190] contemplates the introduction of reinforcing fillers, the role of which is generally familiar to the skilled artisan, in quantities of 20 to 50% relative to the full weight of all the components.

Turning back to Example 1, by the Examiner's calculation, there is a total of about 265.48 parts of water, approximately 0.95 parts of PVA (which satisfies the requirement not only for the water-soluble polymer, but also an emulsifier [0171-0172]),

and 34.08 parts combined of the vinyl-functional polysiloxane and organohydrogensiloxane crosslinker. It is obvious to add to these materials reinforcing silica for its known benefits (mechanical strength, rheological modification, etc.) and the reference advocates adding between 25% and 35% as a fraction of the total. Twenty five percent silica incorporation would correspond to about $(0.25)(300) = 75$ parts of silica. Adding this to the approximately 34.1 parts of the crosslinked silicone-forming materials, there would be $34.1 + 75 = 109.1$ parts of the materials corresponding to (a-1) to (a-4) of the instant invention. Again, 0.95 parts of PVA, which satisfies both the requirement for a water-soluble polymer and an emulsifier, is added relative to 109.1 parts of (a-1) to (a-4). Normalizing to 100 parts of (a-1) to (a-4), there would be 0.87 parts of PVA, which lies within the ranges of both claimed component (C) and the calculated relative amount of (b-1) to (a-1) to (a-4) first determined under the heading "Claim Analysis".

Allowable Subject Matter

Claims 2-3, 5-6, 8-10, 14-15, 17-18, and 20-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The rejection is predicated on the employment of PVA as the water-soluble polymer and the mode of preparation of the emulsion is different than that recited in claims 2 and 3. Claims 11-13 are allowable.

U.S. Patent Nos. 5,827,921, 5,399,402, 4,741,861, 4,624,900, and 7,459,213 are all cited as being of interest but are all deficient as a foundation for finding the rejection unpatentable for one or more reasons.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 5, 2011

/Marc S. Zimmer/
Primary Examiner, Art Unit 1765